

The opinion in support of the remand being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 40

**UNITED STATES PATENT AND TRADEMARK OFFICE**

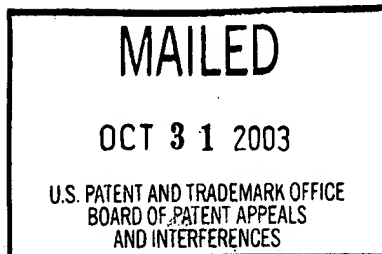
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte GARY A. FREEMAN and WARD M. HAMILTON

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Appeal No. 2004-0126  
Application No. 08/962,271<sup>1</sup>

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**REMAND TO EXAMINER**

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Before FRANKFORT, BAHR, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

**REMAND TO THE EXAMINER**

The above-identified application is being remanded to the examiner for appropriate action.

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<sup>1</sup> Application filed October 31, 1997, for reissue of U.S. Patent No. 5,462,157 (Application No. 08/144,665, filed October 28, 1993).

### BACKGROUND

1. A review of the file record indicates that claims 23, 26, 27 and 29 to 48 have been rejected under 35 U.S.C. § 251 as being improper recapture of subject matter surrendered in the application for the original patent.

2. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert.<sup>2</sup> In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the “surrendered subject matter” was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the “recapture rule.” Slip. op. at 39-45.

### ACTION

We remand this application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

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<sup>2</sup> A copy of the Eggert opinion is attached to this opinion. An electronic copy of Eggert is available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/RC010790.pdf>.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the 35 U.S.C. § 251 rejection. See 37 CFR § 1.193(b)(1). In the event that the examiner furnishes a supplemental answer, the appellants may file a reply brief in accordance with 37 CFR § 1.193(b)(1).

If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

#### CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REMANDED

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